

## **REMARKS/ARGUMENTS**

### **Status of the Claims**

Claims 1-27 remain in the application;

### **Formalities**

In paragraphs 5-9 of the Office Action, the Examiner has taken the position that the evidence submitted by way of the Thomas Mungavan Declaration was insufficient to establish a conception of the invention prior to the effective date of the U.S. Patent No. 6,741,980 (Langseth) reference, and to show due diligence from that date up to Applicant's December 31, 2001 filing date.

For the reasons stated below, Applicant believes that the Langseth reference is not entitled to claim priority based on the March 23, 1999 filing date of the provisional application preceding the Langseth reference relied upon by the Examiner.

Accordingly, Applicant is holding in abeyance filing any supplemental declarations by both inventors to overcome the objections to the Rule 1.131 declaration raised by the Examiner in paragraphs 5-9 of the Office Action.

Applicant reserves the right to submit further Rule 1.131 declarations as necessary and appropriate after the true effective filing date of the Langseth reference has been established.

### **Claim rejections under 35 U.S.C. § 102(b)**

Claims 1-27 stand rejected under 35 U.S.C. 102(b) for being in public use for more than one year prior to the filing date of the present invention, with the Examiner relying on a portion of the Mungavan Declaration that states "*On or about December 26, 2000, the*

system was functioning and delivering subscriptions to customers.”

Applicant disagrees. The “system” does not refer to or identify the “invention”, as claimed. The “system” to which the declaration refers, was in actuality a subsystem that Applicant was developing, but which was not incorporated into the final product. (Hakomaki Declaration, par.4). Applicant submits that “system” has been taken out of context and must be considered in context of the entire Declaration. Namely:

*“On or about January 24, 2000, the basic invention, as conceived, was effectively reduced to practice and demonstrated.”*

*“On or about December 26, 2000, the system was functioning and delivering subscriptions to customers.” and,*

*“Further development of the invention continued until December 31, 2001, at which point the above-captioned patent application was filed.”.*

The “system” as referenced with respect to the activity relied upon by the Examiner is not described or identified in any way; and is to be distinguished from the “invention” as particularly referred to in the above-quoted preceding and following paragraphs of the Mungavan Declaration.

Moreover, the general time frame of “on or about December 26, 2000” does not preclude the inclusion of a later date up to December 31, 2000 or January 1, 2001.

For the foregoing reasons, it is respectfully submitted that Applicant’s statement about the status of an unidentified “system” in December 2006 in the Mungavan Declaration does not set forth facts establishing a basis for an alleged bar to patentability of the invention as claimed, under 35 USC 102 (b).

Applicant requests that the rejection of claims 1-27 be withdrawn and the application be passed to issue.

**Claim rejections under 35 U.S.C. § 102(e)**

Claims 1-6, 8-10, 12-17, and 19-25 stand rejected under 35 USC 102(e) as being anticipated by U.S. Patent No. 6,741,980 (Langseth et al.), with the Examiner asserting that the reference of Langseth, by claiming priority back to provisional patent application number 60/126,055 (inventors Robert Trenkamp and Kyle Yost), has an effective filing date of March 23, 1999.

Applicant respectfully disagrees that the Langseth patent has an effective filing date of March 23, 1999. Not only are the titles of the provisional patent application and the Langseth patent different, the specifications and drawings are different. Under 35 U.S.C. §119(e)(1):

(1) An application for patent filed under **section 111(a)** or **section 363** of this title for an invention disclosed in the manner provided by the first paragraph of **section 112** of this title in a provisional application filed under **section 111(b)** of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under **section 111(b)** of this title, if the application for patent filed under **section 111(a)** or **section 363** of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application

(emphasis added).

35 U.S.C. § 112, first paragraph is as follows:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

"What is claimed by the patent application must be the same as what is disclosed in the specification ..."<sup>1</sup> That is, the specification of the provisional must "contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms," to enable an ordinarily skilled artisan to practice the invention as claimed in the subsequent non-provisional application.<sup>2</sup> Otherwise, the patent cannot claim priority to the provisional patent application.

Applicant notes in independent claim 1, that there is no supporting disclosure for "channels", the "subscription receiving means", the "service processing means" and the "output forwarding means" in the provisional specification. In addition, in independent claim 17, the method as claimed closely follows the method claim flow charts (figures 15-17) of the Langseth patent and not the provisional patent application of Trenkamp and Yost. In particular, the step of "providing one or more channel databases ..." and the step of "receiving subscriptions from a plurality of users ..." are absent from method figures 3 and 4 of the provisional patent application.

It is respectfully submitted that Langseth does not anticipate Applicant's invention, as currently claimed. Applicant submits that claims 1-6, 8-10, 12-17, and 19-25 are not anticipated in view of Langseth and requests that the application be passed to issue.

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<sup>1</sup> Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722, 122 S. Ct. 1831, 1840 (2002).

<sup>2</sup> New Railhead Manufacturing, L.L.C. v. Vermeer Manufacturing Company 298 F.3d 1290; 63 U.S.P.Q.2d 1843.

**Claim rejection under 35 U.S.C. § 103(a)**

Claim 7 stands rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 6,741,980 (Langseth) in view of Official Notice.

Applicant respectfully disagrees. "It is well-established that before a conclusion of obviousness may be based on a combination of references, there must have been a reason, suggestion, or motivation to lead an inventor to combine those references."<sup>3</sup> Langseth discloses a personalized intelligence system that comprises a plurality of databases that are subscribed to on a regular basis, for example an alert service. If the alert service subscription were updated on an hourly basis, it would not make much sense to provide Langseth's system with a feature that would analyze and retransmit information that would soon be outdated. Moreover, such a provision would cause the system to crash if, for example, the hourly update were not received for 24 hours. In such a case, the system would generate multiples of reminders. It would not be obvious to provide the personalized intelligence system of Langseth with a monitoring feedback, as suggested by the Examiner in the Official Notice, which Applicant specifically traverses. Applicants respectfully requests that the Examiner provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test).

It is respectfully submitted that claim 7, as amended, are not obvious in view of Langseth and the Examiner's Office Notice, and Applicant requests that the application be passed to issue.

**Claim rejections under 35 U.S.C. § 103(a)**

Claims 11 and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over

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<sup>3</sup> *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996).

U.S. Patent No. 6,741,980 (Langseth) in view of published U.S. Patent Application No. US 2002/0,052,885 (Levy).

Applicant respectfully disagrees. "It is well-established that before a conclusion of obviousness may be based on a combination of references, there must have been a reason, suggestion, or motivation to lead an inventor to combine those references."<sup>4</sup> Langseth discloses and claims a "personalized intelligence system" in which a user pays to a plurality of data channels. Levy, on the other hand, discloses a "file sharing system" that uses embedded data to identify files. These are two diametrically opposed concepts. There is no reason to combine the references of Langseth and Levy because Langseth and Levy serve divergent purposes. There is no suggestion to combine Langseth and Levy because Langseth's users would not want to share their personal information with third parties. Levy, on the other hand, wants to share files. Levy does want to have some control over who shares files, but the files of Levy are meant to be shared. There is no expectation of privacy. There is not motivation to combine the references of Langseth and Levy other than the Examiner's assertion that "it would have been "obvious to deter file sharing".

It is respectfully submitted that claims 11 and 18 are not obvious in view of Langseth and Levy, and Applicant requests that the application be passed to issue.

## CONCLUSION

On the basis of the foregoing amendments, remarks, and arguments of record, applicant respectfully submits that claims 1-27 are in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Alternatively, if the Examiner is of the opinion that prosecution of the application may be expedited by a telephonic interview, the Examiner is invited to contact applicant's representative at the telephone number listed below.

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<sup>4</sup> Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc., 37 USPQ2d 1626, 1629 (Fed. Cir. 1996).

Customer Number

22854

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Respectfully submitted,  
For the Applicant(s)  
By his/her/their Attorneys,

MOORE & HANSEN PLLP  
225 South Sixth Street  
Suite 4850  
Minneapolis, Minnesota 55402  
Telephone: (612) 332-8200  
Facsimile: (612) 332-1780  
By: James R. Hakomaki  
James R. Hakomaki  
Reg. No. 35,037